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Claims 1-3, 5-7, 9-12, 14-16, 18-20, 52, and 53 now stand rejected under 35 U.S.C 102(e) as being anticipated by McAllister *et al.* (U.S. Patent No. 6,442,242). Claims 4, 13, and 21 now stand rejected under 35 U.S.C § 103(a) as unpatentable over McAllister in view of Bartholomew. As will be shown below, McAllister does not anticipate claims 1-3, 5-7, 9-12, 14-16, 18-20, 52, and 53 and the combination of McAllister and Bartholomew cannot establish a prima facie case of obviousness. The case is in condition for allowance and reconsideration of claims 1-21, 52, and 53 is respectfully requested.

Claim Rejections – 35 U.S.C. §102

Claims 1-3, 5-7, 9-12, 14-16, 18-20, 52, and 53 stand rejected under 35 U.S.C 102(e) as being anticipated by McAllister *et al.* (U.S. Patent No. 6,442,242). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”¹ Because McAllister does not teach each and every element of claims 1-3, 5-7, 9-12, 14-16, 18-20, 52, and 53, the rejection should be withdrawn and the claims should be allowed.

Independent claim 1 claims “[a] method for *externally* identifying a particular caller, said method comprising: receiving a voice utterance for a caller *at a server external to a trusted telephone network . . .*” McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber² by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call.³ McAllister does not disclose “externally identifying a particular caller” including “receiving a voice utterance for a caller at a server external to a trusted telephone network . . .” McAllister does not address trusted and untrusted telephone networks or externally identifying a particular caller. As such, independent claim 1 cannot be anticipated by McAllister and

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² McAllister, column 1, line 7, column 2, lines 29-30.

³ McAllister, column 5, lines 32-67.

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therefore should be allowed. Rejected dependent claims 2-3, 5-7, and 9 depend from claim 1 and include all of the limitations of claim 1. Because McAllister does not teach each and every element of claim 1, McAllister also does not teach each and every element of claims 2-3, 5-7, and 9. Claims 1-9 should be allowed.

Independent claim 10 similarly claims "[a] system for *externally* identifying a particular caller" including "a server system communicatively connected to a trusted telephone network by an *external network*" and "and means for transmitting said caller identity to said *trusted telephone network* as an authenticated identity of said caller for a call." As mentioned above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister does not disclose "[a] system for externally identifying a particular caller" including "a server system communicatively connected to a trusted telephone network by an external network" and "and means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call." McAllister does not address trusted and untrusted telephone networks or externally identifying a particular caller. As such, independent claim 10 is not anticipated by McAllister and therefore should be allowed. Rejected dependent claims 11-12, and 14-16 depend from claim 10 and include all of the limitations of claim 10. Because McAllister does not teach each and every element of claim 10, McAllister also does not teach each and every element of claims 11-12, and 14-16. Claims 10-17 should be allowed.

Independent claim 18 recites "[a] computer program product for *externally* identifying a particular caller" including "means, recorded on said recording medium, for controlling transmission of said caller identity to said *trusted telephone network* as an authenticated identity of said caller for a call." As discussed above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the

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call. McAllister does not disclose “[a] computer program product for externally identifying a particular caller” including “means, recorded on said recording medium, for controlling transmission of said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” Again, McAllister does not address trusted and untrusted telephone networks or externally identifying a particular caller. As such, independent claim 18 is not anticipated by McAllister and therefore should be allowed. Rejected dependent claims 19-21 depend from claim 18 and include all of the limitations of claim 18. Because McAllister does not teach each and every element of claim 18, McAllister also does not teach each and every element of claims 19-21. Claims 18-21 should be allowed.

Independent claim 52 recites “[a] method for controlling caller identification” including “receiving, *from a trusted telephone network*, an authenticated caller identity for a caller at a telephony device, wherein said caller identity is authenticated at a authentication service accessible *via a network external* to said trusted telephone network, wherein said trusted telephone network initiates said authentication service . . .” McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister does not disclose “[a] method for controlling caller identification” including “receiving, from a trusted telephone network, an authenticated caller identity for a caller at a telephony device, wherein said caller identity is authenticated at a authentication service accessible via a network external to said trusted telephone network, wherein said trusted telephone network initiates said authentication service . . .” McAllister also does not address trusted and untrusted telephone networks or externally identifying a particular caller. As such, independent claim 52 is not anticipated by McAllister and should be allowed.

Independent claim 53 recites “[a] method for controlling a call” including “*a secure communication channel via a trusted telephone network to an authentication service . . .*” As discussed above, McAllister describes telephone auto attendant systems including a

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telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister does not disclose "a secure communication channel via a trusted telephone network to an authentication service." McAllister also does not address trusted and untrusted telephone networks or a secure channel via trusted telephone network. As such, independent claim 52 is not anticipated by McAllister and should be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 4, 13, and 21 stand rejected under 35 U.S.C § 103(a) as unpatentable over McAllister in view of Bartholomew. Applicants respectfully traverse the rejection. To establish a prima facie case of obviousness, three basic criteria must be met.⁴ First, the combination must teach or suggest all of Applicants' claim limitations.⁵ Second, there must be a suggestion or motivation to combine the references.⁶ Finally, there must be a reasonable expectation of success in the combination.⁷

The combination of McAllister and Bartholomew does not teach or suggest all of Applicants' claim limitations. As described above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. Bartholomew describes a single network that provides communication services including intelligent peripherals⁸ and TCP/IP network connections.⁹ Bartholomew does not cure the deficiencies of McAllister. Neither McAllister nor Bartholomew disclose or

⁴ Manual of Patent Examining Procedure §2142.

⁵ *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

⁶ *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

⁷ *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

⁸ U.S. Patent No. 6,167,119, column 17, line 62 – column, 18, line 25; ("The illustrated IP also includes . . .").

⁹ U.S. Patent No. 6,167,119, column 9, lines 12-13 ("FIG. 1 provides a simplified illustrated of the preferred intelligent telephone network for implementing the personal dial tone service in accord with the present invention.") U.S. Patent No. 6,167,119 column 11, line 63 – 66 ("The preferred telephone network includes one or more intelligent peripherals (IPs) 23 . . ."); U.S. Patent No. 6,167,119, Figure 1.

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suggest "externally identifying a particular caller" or "trusted telephone networks" as claimed in claims 4, 13 and 21. As such, the combination of McAllister and Bartholomew cannot support a prima facie case of obviousness.

There is no suggestion or motivation to combine McAllister and Bartholomew. As described above, neither McAllister or Bartholomew address trusted and untrusted networks or externally identifying a particular caller. In fact, Bartholomew teaches away from "externally identifying a particular caller" by instead teaching the single preferred network. Therefore, the combination of McAllister and Bartholomew cannot support a prima facie case of obviousness.

There is no reasonable expectation of success in the proposed combination. Because McAllister or Bartholomew does not disclose externally identifying a particular caller or trusted telephone networks, their combination cannot work to disclose externally identifying a particular caller or trusted telephone networks. Said differently, McAllister and Bartholomew cannot together work to disclose what is not disclosed in either reference alone. The combination therefore fails to establish a prima facie case of obviousness.

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Conclusion

McAllister, alone or in combination with Bartholomew, does not teach each and every element of claims 1-21, 52, and 53. McAllister therefore does not anticipate claims 1-5, 7, 9-14, 16, 18-21, 52, and 53. The proposed combination of McAllister and Bartholomew also fails to establish a prima face case of obviousness because the proposed combination does not teach each and every element of the rejected claims, there is no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combination. Applicants respectfully request the allowance of claims 1-21, 52, and 53.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

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By:

Respectfully submitted,



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